

REMARKS

Status of the Claims

Claims 5, 7, 9, 10, and 13 were pending.

Claims 4, 6, 8 and 12 were previously canceled.

Claims 4-13 stand rejected.

Claims 5, 11 and 13 are amended herein.

Claims 14, 15 and 16 are new claims.

Reconsideration is respectfully requested.

Claim Amendments and New Claims

Claim 5 is amended to address antecedent basis issues or inconsistencies in the claim and cover examples falling within the restriction requirement. For example, the formula (left hand) is amended to show two groups R^7 and $R^{7'}$ attached to the same carbon atom. The claim later recites (and previously recited) that two groups R^7 and $R^{7'}$ attached to the same carbon atom may join to form a spiro ring. However, this recitation previously lacked antecedent basis, or was inconsistent with the formulae, because the formulae did not show two groups R^7 and $R^{7'}$ attached to the same carbon atom. Now the claim shows this.

Additionally, claim 5 is amended to recite that R^8 and $R^{8'}$ may join to form a fused heterocyclic or carbocyclic ring. For example, Example 706 shows the groups R^8 and $R^{8'}$ joining to form a fused phenyl ring. The claim was amended to correct this oversight.

Claim 10 was canceled as redundant of claim 5. Claim 10 had recited a method of treating a disorder wherein the disorder is cancer. However, claim 5 was already amended to recite treatment of cancer. Thus, given amendments to claims 5 and 10, the latter no longer further limited the independent claim 5 and was redundant.

Claims 11 and 13 were then amended as they depended upon claim 10, a canceled claim. Given the amendments to claims 11 and 13, new claims 14 -16 are proposed to more narrowly recite the applicant's invention. Claim 16 corresponds to previous claim 4 but, in view of the restriction requirement, lists by name compounds having an indole-1,3-dione core structure. As such, the claimed method reciting use of these compounds falls within the purview of the restriction requirement.

Response to Double Patenting Rejections

The Office Action rejects all pending claims on grounds of obviousness-type double patenting in view of co-pending and commonly-assigned application No. 10/322,077 (now abandoned in favor of a continuation case bearing Serial No. 10/974,049).

Applicant brings to the Examiner's attention that the claims of said co-pending case have been amended since the filing and publication of the case. Double-patenting depends upon the *claims* of the commonly-assigned patents or co-pending applications, not the disclosure. See, e.g., MPEP 804 ("a double patenting rejection must rely on a comparison with *the claims* in an issued to be issued patent").

Attached hereto for the Examiner's convenience is a copy of the latest amendment in application Serial No. 10/322,077, now abandoned in favor of application Serial No. 10/974,049, showing the most recent claims. As can be seen, each of the claims in the '049 application require the presence of a core structure having an epoxide ring or other oxygen-containing bridge [i.e., Y is $-(CR^7R^7')_n-\underline{O}-(CR^7R^7')_n$]; whereas in the instant case, the group -Y- is recited as $(CR^7R^7')_n$ and $n = 1-3$ and thus does not contain an oxygen atom. These different core structures are not obvious in view of each other. See, e.g., *Ex parte Biel*, 137 USPQ 315 (Bd. Pat. App. 1962) (different ring systems, e.g., thienyl, pyridyl, or furyl were not obvious and separately patentable over cyclohexyl rings even though they had the same tertiary amine substitution).

Accordingly, applicant respectfully requests that the double-patenting rejection be withdrawn.

FEES

Three new claims have been added including one independent claim. However, the case contains less than twenty claims and three independent claims. Thus, it is believed no fee is due. However, in the event it is determined a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb.

SUMMARY

It is believed that the instant claims are in condition for allowance. The Examiner is invited to contact the undersigned if it is believed a telephonic communication would expedite the prosecution of this application.

Respectfully submitted,



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